

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the amendments and following discussion is respectfully requested.

Claims 1, 2, 4-8, 10-12, 14-16, and 18-20, 22 are pending in this application. Claims 1, 2, 3-8, 10-12, 14-16, and 18-20, 22 are rejected. Claims 1 and 12 are amended by this response. Claims 3, 13, and 21 are cancelled without prejudice or disclaimer. No new matter is added and no new issues are presented. In amending Claims 1 and 12, the feature of the dependant Claims 3 and 13 was added to Claims 1 and 12, respectively.

Amended Claims 1 and 12 are the only independent claims in the application. Claims 2, 4-8 and 10-11 depend from amended Claim 1. Claims 14-16 and 18-20, 22 depend from amended Claim 12. Claims 1-8, 12, 14-16, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Honey et al. (US 5,564,698), hereinafter Honey '698, in view of Honey (US 5,912,700), hereinafter Honey '700, in further view of Bledsoe (US 5,742,237), hereinafter Bledsoe. Claims 10, 11, and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Honey '698, in view of Honey '700, in further view of Maleyko (US 5,228,686) "Maleyko." The aforementioned rejections are respectfully traversed and reconsideration is requested in light of the following discussion.

Applicant thanks the Examiner and his Supervisor for the interview conducted on July 17, 2007. During the interview, arguments substantially as hereinafter developed were presented, and the Examiners acknowledged that the arguments accurately characterized the prior art. No formal agreement was reached, pending the Examiners' formal reconsideration upon formal consideration of a written response to the outstanding Office Action.

As noted above, Applicant has also amended Claims 1 and 12 to incorporate a second timer. The second timer was previously recited in cancelled Claim 3, for example, and this claim modification therefore is not believed to raise new issues for consideration.

Also, Applicant notes that the Office Action's 35 U.S.C. § 103(a) rejection of Claims 10, 11, and 18-20 omits reliance on the Bledsoe reference. Applicant submits that as Claims 10, 11, and 18-20 are dependent on either Claim 1 or Claim 12, they have at least the features of the independent claims. The Office Action does not assert that Maleyko has a timer; whereas in the primary rejection the Office Action asserts Bledsoe has a timer. The second rejection, relying on Maleyko, therefore is traversed as not being proper under 35 U.S.C. § 103(a) rejection in the absence of a prima face showing that all the elements are disclosed in the cited references. Applicant respectfully requests reconsideration and withdrawal of this rejection. In the case where the Office Action mistakenly omitted the Bledsoe reference from this rejection, Applicant submits that these dependant claims are still allowable based on the following remarks.

35 U.S.C. § 103(a) Rejection of Claim 1

Amended Claim 1 recites:

1. A golf ball comprising:
a substantially spherical shaped body having a dimpled outer surface;
a power source contained within the body;
a transmitter coupled to the power source and configured to emit an electromagnetic signal;
a shock actuated switching device contained within the body;
a first timer configured to delay turning the transmitter on for a predetermined time after actuation of the switching device; and
a second timer configured to turn the transmitter off a predetermined time after actuation of the switching device.

Amended Claim 12 recites:

12. A golf ball comprising:
a substantially spherically shaped body having a dimpled outer surface;
a power source contained within the body;
a transmitter coupled to the power source and configured to emit an electromagnetic signal;
means for delaying turning the transmitter on for a predetermined time after application of a shock to the golf ball; and
a timer configured to turn the transmitter off a predetermined time after turning the transmitter on.

With regards to the “first timer” and “means for delaying,” the Office Action rejected independant Claims 1 and 12 and dependant Claims 2, 4-8, 12, 14-16, and 22 under 35 U.S.C. § 103(a) asserting it would be obvious to modify Honey ‘698, in light of Honey ‘700, in light of Bledsoe “to provide a mechanism to turn on a transmitter after a delay of time such as a few seconds to a couple of minutes to conserve a finite power source such as a battery after the device has been activated by a switch of some sort.”¹ However, Applicant respectfully traverses this rejection on the basis that the suggested modification renders the primary reference, Honey ‘698, unsuitable for its intended purpose and, in doing so, is directly adverse to the teachings of Honey ‘698. Further, assuming *argumendo* such a modification would not render Honey ‘698 unsuitable, none of the references, in isolation or in combination, teaches or suggests the features of amended independent Claim 1.

More particularly, for a 35 U.S.C. § 103(a) rejection, MPEP 2143.01 states that, if the proposed modification renders the prior art unsatisfactory for its intended purpose, then it is not a proper combination.² This basis for finding improper combination, i.e., a teaching of a secondary reference rendering the primary reference unsatisfactory for its intended purpose, may be taken from *KSR Int’l Co. v. Teleflex Inc.*, hereinafter KSR. A combination “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art” (although Applicant asserts the elements are not found in the Office Action’s cited references).³ The proper question is whether one of ordinary skill in the art would “have seen a benefit to upgrading” the primary reference with an element of the other reference.⁴ The answer to this question of “upgrading” is a clear “no.”

Further, KSR requires that the reason for the combination and why the combination yields the invention “must be made explicit, [as] rejections on obviousness grounds cannot be

¹Office Action of May 18 at page 5.

² *In Re Gordon*, 733 F.2d 900 (Fed. Cir 1984); *see also* MPEP 2143.01(v).

³ 119 Fed. Appx. 282.

⁴ *Id.*

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁵ The Office Action does not give a valid reason why the elements should be combined; as the stated combination is inimical to the teaching of Honey rendering it unfit for its intended purpose as explained herein. Nor does it state how a modification of these references would result in the golf ball of amended Claim 1 as the cited elements function differently than those of amended Claim 1.

Turning now to the cited references, Honey ‘698 states that “the present invention provides for a hockey puck that transmits electromagnetic signals outside of the visible spectrum that can be detected by appropriate sensors in order to make the hockey puck more visible to the television user.”⁶ The impetus to make the puck more visible was that “hockey has not been a popular sport for television because of the problems in television coverage . . . poor visibility and distortion of the hockey puck.”⁷ “It is difficult to follow the puck from player to player, and it is especially difficult to follow the puck as it is shot toward the goal and either deflected, caught, or missed by the goalie.”⁸ “Because viewers cannot follow the puck, they do not sustain interest in the game.”⁹ Therefore, “[t]he present invention is directed to overcome the disadvantages of the prior art . . . to make the hockey puck more visible to the television user.”¹⁰ As the teaching of Honey ‘698 is to make the hockey puck more visible, making the puck less visible, as would result adding a time delay as suggested by the Office Action, teaches away from the purpose of Honey ‘698.

The intended purpose of Honey ‘698 is to increase the “viewability” of a hockey puck for a television viewer. In the context of the Honey ‘698 disclosure, this would likewise be

⁵ Id.

⁶ Honey ‘698, Column 2, lines 38-43.

⁷ Honey ‘698, Column 1, lines 19-30.

⁸ Honey ‘698, Column 1, lines 36-39.

⁹ Honey ‘698, Column 1, lines 43-45.

¹⁰ Honey ‘698, Column 2, line 36.

true of a golf ball, i.e. the purpose of Honey '698 as applied to a golf ball would be to improve the viewability of a golf ball. In hockey, the puck immediately moves after it is hit and, per the Office Action, moves at a high velocity.¹¹ Inserting a delay after actuation of the hockey puck would not increase the viewability of the hockey puck to the television user. Rather, by delaying the amount of time the puck is in play and transmitting, the viewability of the puck by the television audience is reduced and the usefulness of Honey '698 is removed.

Therefore, Applicant submits the modification proposed by the Office Action to insert "a delay of time such as a few seconds to a couple of minutes" would render Honey '698 useless for its intended purpose as the puck would no longer transmit its path as it travels around the rink. Specifically, Honey '698 states that "while in play, the puck should always be on."¹² Accordingly, a combination, such as modifying the teachings of Honey '698 as suggested in the Office Action,¹³ would make the puck less visible and is in conflict with and teaches away from the teaching of Honey '698.

Further, as best understood by Applicant, the modification proposed by the Office Action would insert a delay timer after actuation of the Honey '698 hockey puck. Per Honey '698, the puck is continually actuated while in play. Continual actuation might actually continually reset any such delay timer. If the Honey '698 were continually actuated while in play, such a combination would continually reset the delay timer and the hockey puck would never transmit the puck's position when in play. As a result, the Office Action's proposed modification is not consistent with the purpose and functionality disclosed by Honey '698. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Applicant respectfully submits that the Office Action's motivation for combination is not taught or suggested in either Honey '698 or Bledsoe and is directly adverse to Honey

¹¹ Office Action of May 18, Page 4.

¹² Honey '698, Column 7 lines 64-65.

¹³ "It would be further obvious to modify Honey '698 in view of Bledsoe . . . delay of time such as a few seconds to a *couple of minutes*." Office Action of May 18, Page 5.

'698's stated purpose of making the puck more visible. Honey '698 teaches "prolonging the life of the battery" by "prevent[ing] pucks *not in use* from transmitting."¹⁴ Honey '698 does not teach conserving power *when the puck is in use*. More particularly, Honey '698 teaches puck visibility when the puck is in use and power conservation when the puck is not in use. It does not teach or suggest power conservation when the puck is in use as suggested by the Office Action as this would not enable Honey '698 to fulfill its stated purpose of making the puck more visible.

Recapitulating, amended Claim 1, in applicable part, states "a first timer configured to delay turning the transmitter on for a predetermined time after actuation of the switching device." While the Office Action states that each component of the current apparatus is present, amended Claim 1 has a structural feature such that the "first timer [is] configured to delay turning the transmitter on." The Bledsoe timer reference functions differently than the timer of amended Claim 1 and Bledsoe does not disclose a "first timer configured to delay turning the transmitter on." In fact, Bledsoe teaches a transmitter characterized by intermittent transmissions and is silent about initialization or initiation of initial transmission.

Applicant respectfully submits that Bledsoe does not teach or suggest inserting a delay before the first transmission. Bledsoe merely teaches "random and infrequent short duration . . . transmissions."¹⁵ This does not teach or suggest that there is a delay before the first transmission of the device once it is activated. Rather, Bledsoe merely teaches intermittent steady state transmission for the life of the battery powering the transmission, does not teach how transmission is initiated, and clearly fails to teach or obviate that there is a delay after initial activation or why such a delay would be desirable. Therefore, there is no teaching or suggestion for "a first timer configured to delay turning the transmitter on for a predetermined time after actuation of the switching device."

¹⁴ Honey '698 Column 6, lines 45-49.

¹⁵ Bledsoe, Column 5, lines 26-30

There is also no teaching or suggestion in Bledsoe of an activation switch. Rather with such a long life and in view of Bledsoe's stated goal for circuit simplicity¹⁶, it is reasonable to speculate that the tags are configured to transmit from the moment they are manufactured. However, what is certain is that Bledsoe is silent on an activation switch and provides no teaching or motivation of any method for activation, nor does Bledsoe teach an initial delay before transmission.

With respect to the additional feature of "a second timer configured to turn the transmitter off a predetermined time after actuation of the switching device," Honey '698 and Bledsoe are in conflict as to teaching whether there should be a device that deactivates the transmission device based on external input (such as what the Office Action submits is Honey '698's actuator). In that regard, Bledsoe states that the reason why his tags are inexpensive and long lasting is the relative simplicity of the tags.¹⁷ Bledsoe does not have a mechanism that turns off transmission after a set period of time. Rather, Bledsoe discloses a device characterized by intermittent transmission of indefinite time period until the power source is exhausted.¹⁸ Thus, not only does Bledsoe's device lack an actuation feature, but also Bledsoe's device lacks a deactivation mechanism.¹⁹ Accordingly, Bledsoe's device would be frustrated by a system that turned the transmitter off after a given time period pending external actuation; as some device to detect the actuation would have to be added to the Bledsoe system. In fact, Bledsoe states his invention "is made possible by elimination of the requirement that each tag have a receiver for receiving an interrogation signal from an interrogator, as is required by nearly known systems."²⁰

Further, Applicant submits that because the purpose of these references is different, their teachings are also in conflict. Honey '698 is directed to increasing the viewability of a

¹⁶ Bledsoe, Column 3, lines 39-60.

¹⁷ Bledsoe, Column 3, lines 39-60.

¹⁸ Bledsoe, Column 20, 45-58.

¹⁹ Bledsoe, Column 19, lines 45-65.

²⁰ Bledsoe, Column 5 lines 40-43.

hockey puck for the TV audience, something that needs nearly constant transmission. In comparison, Bledsoe's random and infrequent transmissions are well suited for his warehouse monitoring system designed to track inventory in a manufacturing process. Just as transmission every couple of seconds to a couple of minutes would be too slow for the Honey '698 reference, almost constant transmission would unnecessarily waste battery power in Bledsoe. Further, balancing the cost of adding a component to "turn on" the Bledsoe system against Bledsoe's invention purported 7-year life, Bledsoe submits it is cheaper and more economical simply to leave the sensors on during that 7-year life. Therefore, what the Bledsoe reference teaches is in conflict with what the Honey '698 reference teaches.

In light of these arguments, it is requested that amended Claim 1 be given favorable reconsideration and the rejection based on 35 U.S.C. § 103(a) be withdrawn. As amended, Claim 12 states substantially similar subject matter with the "means for delaying turning the transmitter on" in means plus function format, Claim 12 should be allowable for at least the same reasons. As amended Claims 1 and 12 are now believed allowable and Claims 2, 4-8 depend from amended Claim 1 and Claims 14-16 and 22 depend from amended Claim 12, the dependent claims are allowable for at least the same reasons as amended Claims 1 and 12 are allowable.

35 U.S.C. § 103(a) Rejection of Claim 2

Further, Claim 2 claims other patently distinct material.

Claim 2 states:

2. The golf ball of claim 1, wherein the first timer is configured to turn the transmitter on several seconds after actuation of the switching device.

In stating that the "first timer is configured to turn the transmitter on several seconds after actuation of the switching device," Claim 2 is directed to an embodiment where specific

information can be captured several seconds into the flight path. Through claim differentiation, this also points out several other embodiments in amended independent Claim 1, such as where flight information could be captured a second or so into flight of the golf ball to provide the golfer with information about his swing and flight information. Other embodiments include, but are not limited to, turning the transmitter on at a sufficient delay as to only provide information to locate the golf ball, hence only using transmitting power to locate the golf ball when it is at rest.

However, the Office Action's proposed modification, as best understood by Applicant, would modify Honey '698, to create an apparatus, such as a hockey puck, that transmits once every couple seconds to once every couple minutes after actuation of the device. This would create a device that, at best, would provide sporadic tracking information seconds after actuation and the start of any motion and would frustrate the goal of Honey '698 to improve viewability of hockey action, once again rendering Honey '698 unfit for its intended purpose.

Conversely, the embodiment of Claim 2 successfully performs its intended purpose of relaying information regarding locating the golf ball, transmitting several seconds after actuation. Unlike the teaching of Bledsoe, the golf ball does not need to transmit indefinitely until the power source is depleted. Rather, Applicant teaches to delay actuation, typically for a short period of time ("several seconds") until the golf ball is well into its flight path or probably no longer moving and, for location purposes, only needs to relay its final position to be found.

In light of these arguments, it is requested that Claim 2 be given favorable reconsideration and the rejection based on 35 U.S.C. § 103(a) be withdrawn. Claim 22, with the "means for delaying . . . several seconds" in means plus function format, should be allowable for at least the same reasons as Claim 2. Claims 2 and 22 are allowable and Claims

Application No. 10/616,905
Reply to Office Action of May 18, 2007

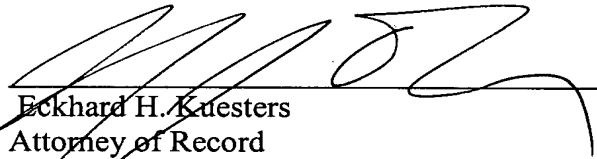
4-8 depend from Claim 2, the dependent claims are allowable for at least the same reasons as Claims 2 and 22 are allowable.

In view of the foregoing, Applicant believes that the application is in condition for allowance and respectfully request favorable reconsideration.

Should the Examiner deem personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at 703-413-3000.

Respectfully submitted,

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